

REMARKS

Claims 8-14 were rejected. Claim 8 is amended to incorporate the limitations of dependent claim 9. Claims 10 and 13 are also amended. Claim 9 is cancelled. Claims 8 and 10-14 are now pending. The above amendments and the following remarks are considered by Applicants to overcome each rejection raised by the Examiner and to place the application in condition for allowance.

Rejection of claims 8 and 12-14 pursuant to 35 U.S.C. § 103

The Examiner rejected claims 8 and 12-14 pursuant to 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. App. Pub. 2004/0001253 to Abe (“Abe”).

Abe discloses an illuminating optical system that can be implemented in different types of microscopes. Figure 3 shows an inverted microscope with an illuminating optical system according to a first embodiment. Figure 12 shows an upright microscope with an illuminating optical system according to a sixth embodiment. Abe’s system is easily switchable between evanescent (using total reflection) and ordinary reflecting illumination, forms a compact entire system, and provides a microscope with its illuminating system. But while Abe’s illumination can be switched, its imaging system must remain the same.

Thus, Abe does not disclose an invertible optical microscope “which can be assembled as an upright variant or as an inverted variant,” as required by claim 8. The upright and inverted variants of the claimed microscope are not different embodiments. Each embodiment of the claimed invention can change the microscope’s imaging system between an upright variant and an inverted variant. While Abe can change its illumination, Abe cannot change its imaging system. Thus, Abe does not disclose an invertible optical microscope “which can be assembled as an upright variant or as an inverted variant.” Further, it would not have been obvious to add this central feature of claim 8 to the teachings of Abe, and the Examiner does not argue to the contrary.

The Examiner may contend that language in a preamble does not limit a claim. The body of claim 8, however, recites the need for an “upright variant” and “inverted variant.” Further, the effect of a preamble must be determined on a case-by-case basis. *MPEP* 2111.02. “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Id.* (citations omitted) Here, the

requirement that the microscope be capable of being assembled as an upright or inverted variant is necessary to give life, meaning, and vitality. The body of the claim would not be understandable absent this limitation. Further, “[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation.” *Id. (I)* (citations omitted)

For these reasons, Applicants respectfully submit that it would not have been obvious for one of ordinary skill in the art to arrive at the invention of independent claim 8 or dependent claims 12-14. Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of claims 10-11 and 13-14 pursuant to 35 U.S.C. § 103

The Examiner rejected claims 10-11 and 13-14 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Abe in view of DE 18 07 713 to Michel (“Michel”).

Michel discloses a microscope that can be assembled from different, largely interchangeable structural components that are self-contained. Michel, however, does not disclose a microscope that can “outfit both microscope variants alternately with vertical illumination or transmitted illumination,” as required by amended claim 8 (and previously required by dependent claim 9). By this claim language, claim 8 specifies that both the upright variant of the microscope and the inverted variant of the microscope must be capable of working with both reflected light and transmitted light. Thus, claim 8 requires that the microscope include four potential variants.

Michel does not disclose an illumination system for use with transmitted light. Thus, Michel cannot perform all four variants, and therefore cannot disclose a microscope that “can outfit both microscope variants alternately with vertical illumination or transmitted illumination” Further, it would not have been obvious to add this central feature of the invention to the teachings of Michel, and the Examiner has not provided an argument to the contrary.

For these reasons, Applicants respectfully submit that it would not have been obvious for one of ordinary skill in the art to arrive at the invention of independent claim 8 or dependent claims 10-11 or 13-14. Accordingly, Applicants respectfully request withdrawal of the rejection.

An early action on the merits of these claims is respectfully requested.

Respectfully submitted,



Eugene LeDonne
Reg. No. 35,930
Joseph Miller, III
Reg. No. 61,748
Joseph T. Lollar
Reg. No. 60,975

REED SMITH LLP
599 Lexington Avenue
29th Floor
New York, NY 10022
(P) 212-521-5400

Attorney for Applicant